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OFFICE OF PETITIONS

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PATENT GROUP
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In re Patent No. 7,531,168 : DECISION ON REQUEST FOR
O'HARA et al. : RECONSIDERATION OF
Issue Date: May 12, 2009 : PATENT TERM ADJUSTMENT AND
Application No. 10/076,934 : NOTICE OF INTENT TO ISSUE
Filed: February 15, 2002 : CERTIFICATE OF CORRECTION
Attorney Docket No. WYS-00701 :

This is a decision on the petition filed on July 8, 2009, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by five hundred ninety-four (594) days.

The petition to correct the patent term adjustment indicated on the above-identified patent is **GRANTED to the extent indicated herein**. The term of the above-identified patent is extended or adjusted by **four hundred seventy-three (473) days**.

A review of the application history reveals that a period of reduction of 43 days was entered under 37 CFR 1.704(c)(10) for the filing of a "REQUEST TO RE-APPLY FEES PREVIOUSLY PAID" on March 31, 2009. It is noted that the submission of a Fee(s) Transmittal (PTOL-85B) is identified as one of the papers the filing of which the Director has specifically deemed not to be a "failure to engage in reasonable efforts" within the meaning of 37 CFR 1.704 (c)(10). See MPEP 2732. Under the circumstances, no reduction is warranted for the filing of the paper requesting

only that the previously paid issue fee be reapplied. Thus, the reduction of 43 days is not merited and will be removed.

The record further reveals that patentee have been assessed delay under 37 CFR 1.704(c)(10) for the submission of the Supplemental Information Disclosure Statement (IDS) on November 6, 2008, the Request for Continued Examination (RCE) and IDS on November 10, 2008, and the petition to withdraw from issue on December 3, 2008.

37 CFR 1.704(c)(10) provides:

Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper;

or

(ii) Four months;

In this instance, it is undisputed that patentee submitted the IDS on November 6, 2008, the RCE and IDS on November 10, 2008, and the petition to withdraw from issue on December 3, 2008, after the mailing of the notice of allowance on July 16, 2008 (and payment of the issue fee on October 16, 2008). Furthermore, a review of IDS submitted on November 6, 2008, and November 10, 2008, reveals that they did not include a proper statement under § 1.704(d).¹ Thus, patentee failed to engage in reasonable

¹ The Office reminds patentee that 37 CFR 1.704(d) was revised, effective May 24, 2004. Specifically, "Section 1.704(d) [was] amended to change 'cited in a communication' to 'first cited in any communication' in order to clarify that the item must have been first cited in **any communication** from a foreign patent office in a counterpart application **instead of merely being cited in such a communication.**" 69 FR 21704 (Apr. 22, 2004) (Emphasis added). Therefore, the required statement under 37 CFR 1.704(d) reads, in pertinent part, that:

efforts to conclude prosecution of the application pursuant to 37 CFR 1.704(c)(10).

Pursuant to 37 CFR 1.704(c)(10), patentee should have been assessed the following periods of reduction:

- 56 days for the submission of the IDS on November 6, 2008, after the mailing of the notice of allowance (and payment of the issue fee), from November 6, 2008, the date the IDS was filed, to December 31, 2008, the mailing date of the notice of allowance in response to the IDS.
- 52 days for the submission of the RCE and IDS after the mailing of the notice of allowance (and payment of the issue fee) on November 10, 2008, from November 10, 2008, the date the RCE and amendment were filed, to December 31, 2008, the mailing date of the notice of allowance in response to the RCE and IDS; and,
- 2 days for the submission of the petition to withdraw from issue after the mailing of the notice of allowance (and payment of the issue fee) on December 3, 2008, from December 3, 2008, the date the petition was filed, to December 4, 2008, the mailing date of the decision in response to the petition.

37 CFR 1.704(c) provides that "[c]ircumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application ... will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping." (Emphasis added).

[E]ach item of information contained in the information disclosure statement was first cited in **any** communication from a foreign patent office in a counterpart application **and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement.** This thirty-day period is not extendable.

(Emphasis added).

In this instance, the periods under 37 CFR 1.704(c)(10) overlap. Specifically, the period of reduction for the submission of the IDS on November 6, 2008, from November 6, 2008 to December 31, 2008, completely overlaps the other periods of reduction. Therefore, a single period of reduction of 56 days will be entered.

With regard to the delay under 37 CFR 1.702(b), patentee is reminded that the period from the filing date of the request for continued examination (RCE) to the issue date of the patent is not included in the B delay period. Thus, the over three year period begins on February 16, 2005, and ends on May 17, 2006, the day before the RCE was filed, and is 456 (not 457) days. See 35 U.S.C. 154(b)(1)(B)(i).

Further, the Office notes that patentee failed to account for the filing of the notice of appeal on March 15, 2006. The Office reminds patentee that the period consumed by appellate review, whether successful or not, is excluded from the calculation of B delay. See 35 U.S.C. 154(b)(1)(B)(ii).

In this instance, the period consumed by appellate review is 64 days, beginning on the date on which the notice of appeal to the Board of Patent Appeals and Interferences was filed, March 15, 2006, and ending on the day before the filing of the RCE, May 17, 2006. Thus, B delay is 392 days (456 - 64).

In view of the above, the patent term adjustment is 473 days (507 days of A delay + 392 days of B delay - 426 days of applicant delay).

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentee is given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

The Office acknowledges the previous submission of the \$200.00 fee set forth in 37 CFR 1.18(e).

This matter is being referred to the Certificates of Correction Branch for issuance of a certificate of correction. The Office

will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **four hundred seventy-three (473) days**.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT: 7,531,168 B2

DATED: May 12, 2009

DRAFT

INVENTOR(S): O'Hara et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 94 days

Delete the phrase "by 94 days" and insert – by 473 days--

PTA Calculations for Application: 10/076934

Application Filing Date:	02/15/2002	PTO Delay (PTO):	507
Issue Date of Patent:	05/12/2009	Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	413
Post-Issue Petitions:	0	Total PTA (days):	473
PTO Delay Adjustment:	379		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
145	05/09/2010	ADJUSTMENT OF PTA CALCULATION BY PTO	392		
144	05/09/2010	ADJUSTMENT OF PTA CALCULATION BY PTO	392		
143	05/09/2010	ADJUSTMENT OF PTA CALCULATION BY PTO		392	
142	05/09/2010	ADJUSTMENT OF PTA CALCULATION BY PTO		56	
141	05/09/2010	ADJUSTMENT OF PTA CALCULATION BY PTO	43		
136.5	04/22/2009	PTA 36 MONTHS			
136	05/12/2009	PATENT ISSUE DATE USED IN PTA CALCULATION			
135	04/06/2009	EXPORT TO FINAL DATA CAPTURE			
134	04/03/2009	DISPATCH TO FDC			
133	04/02/2009	APPLICATION IS CONSIDERED READY FOR ISSUE			
132	03/31/2009	ISSUE FEE PAYMENT VERIFIED			
131	03/31/2009	MISCELLANEOUS INCOMING LETTER		43	
130	03/31/2009	ISSUE FEE PAYMENT RECEIVED			
128	03/24/2009	MAIL-PETITION DECISION - DISMISSED			
127	03/24/2009	PETITION DECISION - DISMISSED			
126	01/02/2009	EXPORT TO INITIAL DATA CAPTURE			
125	12/31/2008	MAIL NOTICE OF ALLOWANCE			
124	12/29/2008	ISSUE REVISION COMPLETED			
123	12/29/2008	DOCUMENT VERIFICATION			
122	12/29/2008	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
121	12/22/2008	NOTICE OF ALLOWABILITY			
120	11/10/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
119	12/22/2008	DATE FORWARDED TO EXAMINER			
		REQUEST FOR CONTINUED EXAMINATION			

118	11/10/2008	(RCE)			
117	12/22/2008	DISPOSAL FOR A RCE / CPA / R129			
112	12/04/2008	MAIL-RECORD PETITION DECISION OF GRANTED TO WITHDRAW FROM ISSUE			
111	12/04/2008	RECORD PETITION DECISION OF GRANTED TO WITHDRAW FROM ISSUE			
110	12/03/2008	PETITION ENTERED			
108	10/28/2002	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
107	11/10/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
106	11/06/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
105	11/10/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
104	11/10/2008	WORKFLOW - REQUEST FOR RCE - BEGIN			
103	11/06/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
102	11/06/2008	REFERENCE CAPTURE ON IDS			
101	11/06/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
100	10/16/2008	PETITION ENTERED			
99	10/16/2008	ISSUE FEE PAYMENT VERIFIED			
98	10/16/2008	ISSUE FEE PAYMENT RECEIVED			
97	09/17/2008	FINISHED INITIAL DATA CAPTURE			
96	07/24/2008	SEQUENCE FORWARDED TO PUBS ON TAPE			
95	07/18/2008	EXPORT TO INITIAL DATA CAPTURE			
94	10/28/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
93	07/16/2008	MAIL EXAMINER'S AMENDMENT			
92	07/16/2008	MAIL NOTICE OF ALLOWANCE			
91	07/14/2008	ISSUE REVISION COMPLETED			
90	07/14/2008	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
89	07/14/2008	CASE DOCKETED TO EXAMINER IN GAU			
88	07/14/2008	DOCUMENT VERIFICATION			
87	07/14/2008	EXAMINER'S AMENDMENT COMMUNICATION			
86	07/14/2008	NOTICE OF ALLOWABILITY			
82	05/07/2008	DATE FORWARDED TO EXAMINER			
81	04/24/2008	RESPONSE AFTER NON-FINAL ACTION			

80	05/05/2008	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
79	01/24/2008	MAIL NON-FINAL REJECTION			
78	01/22/2008	NON-FINAL REJECTION			
77	10/31/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
76	10/31/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		0	70
75	10/31/2007	REFERENCE CAPTURE ON IDS			
74	10/31/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
73	11/24/2007	DATE FORWARDED TO EXAMINER			
72	10/31/2007	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
71	11/24/2007	DATE FORWARDED TO EXAMINER			
70	10/31/2007	REQUEST FOR CONTINUED EXAMINATION (RCE)			
69	11/24/2007	DISPOSAL FOR A RCE / CPA / R129			
68	10/31/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
67	10/31/2007	WORKFLOW - REQUEST FOR RCE - BEGIN			
66	09/26/2007	MAIL ADVISORY ACTION (PTOL - 303)			
65	09/25/2007	ADVISORY ACTION (PTOL-303)			
64	09/11/2007	DATE FORWARDED TO EXAMINER			
63	09/10/2007	AMENDMENT/ARGUMENT AFTER NOTICE OF APPEAL			
62	09/10/2007	NOTICE OF APPEAL FILED		94	56
61	09/10/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
58	08/04/2003	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
57	08/04/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
56	03/08/2007	MAIL FINAL REJECTION (PTOL - 326)			
55	03/05/2007	FINAL REJECTION			
54	02/01/2007	DATE FORWARDED TO EXAMINER			
53	01/25/2007	RESPONSE AFTER NON-FINAL ACTION		92	49
52	01/25/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
51	12/26/2006	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			

50	12/20/2006	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
49	07/25/2006	MAIL NON-FINAL REJECTION			
48	07/20/2006	NON-FINAL REJECTION			
47	05/24/2006	DATE FORWARDED TO EXAMINER			
46	03/15/2006	RCE- AF PROCESSED			
45	05/24/2006	DATE FORWARDED TO EXAMINER			
44	05/18/2006	REQUEST FOR CONTINUED EXAMINATION (RCE)			
43	05/24/2006	DISPOSAL FOR A RCE / CPA / R129			
42	05/18/2006	WORKFLOW - REQUEST FOR RCE - BEGIN			
41	04/10/2006	MAIL ADVISORY ACTION (PTOL - 303)			
40	04/05/2006	ADVISORY ACTION (PTOL-303)			
39	03/27/2006	CORRESPONDENCE ADDRESS CHANGE			
38	03/27/2006	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)			
37	03/17/2006	DATE FORWARDED TO EXAMINER			
36	03/15/2006	AMENDMENT/ARGUMENT AFTER NOTICE OF APPEAL			
35	03/15/2006	NOTICE OF APPEAL FILED		91	33
34	03/15/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
33	09/14/2005	MAIL FINAL REJECTION (PTOL - 326)			
32	09/12/2005	FINAL REJECTION			
31	07/08/2005	DATE FORWARDED TO EXAMINER			
30	06/27/2005	RESPONSE AFTER NON-FINAL ACTION		92	27
29	06/27/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
28.7	06/27/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
28	06/27/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
27	12/27/2004	MAIL NON-FINAL REJECTION			
26	12/21/2004	NON-FINAL REJECTION			
25	11/10/2004	DATE FORWARDED TO EXAMINER			
24	11/02/2004	RESPONSE TO ELECTION / RESTRICTION FILED			
23	11/02/2004	REQUEST FOR EXTENSION OF TIME - GRANTED			
22	11/02/2004	WORKFLOW INCOMING AMENDMENT IFW			
21	09/03/2004	MAIL RESTRICTION REQUIREMENT	507		-1

20	09/01/2004	REQUIREMENT FOR RESTRICTION / ELECTION			
19	06/28/2004	CASE DOCKETED TO EXAMINER IN GAU			
18	04/06/2004	CASE DOCKETED TO EXAMINER IN GAU			
17	07/10/2003	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
15	11/02/2002	CASE DOCKETED TO EXAMINER IN GAU			
14	06/19/2002	AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED			
13	06/19/2002	NEW OR ADDITIONAL DRAWING FILED			
12	08/20/2002	APPLICATION DISPATCHED FROM OIPE			
11	07/31/2002	APPLICATION IS NOW COMPLETE			
10	06/19/2002	ADDITIONAL APPLICATION FILING FEES		1	5
9	06/19/2002	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			
8	06/19/2002	APPLICANT HAS SUBMITTED NEW DRAWINGS TO CORRECT CORRECTED PAPERS PROBLEMS			
7	07/15/2002	MAIL-RECORD PETITION DECISION OF GRANTED RELATED TO FILING DATE			
6	06/19/2002	PETITION ENTERED			
5	03/18/2002	NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED			
4	03/14/2002	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
3	03/02/2002	IFW SCAN & PACR AUTO SECURITY REVIEW			
2	02/19/2002	CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT			
1	02/19/2002	INITIAL EXAM TEAM NN			

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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